REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 16-17 and 22-27 are currently pending in this application. No claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b)

Claims 16-17, 22 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hakuta (WO 01/98407 and its U.S. equivalent, U.S. 6,743,862) (hereinafter Hakuta '407). This rejection is respectfully traversed.

The Examiner asserts that Hakuta '407 discloses a method of preparing molded products made of various rubber compositions comprising "components A), B), C) D) and E)". The Examiner further asserts that the composition can be kneaded and the molding process can be injection molding. In response to previously presented arguments regarding component "B", the Examiner states that "the claimed organopolysiloxane B) is not necessarily present" in the composition of the present invention.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C.§102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*,

9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

Independent claims 16 and 17 are directed to a method for making a sealing or gasket material comprising the steps of kneading, molding and crosslinking a rubber composition, wherein the rubber composition comprises an organopolysiloxane (B) having a specific formula. According to MPEP §211.03, the term "comprising" is "a term of art used in claim language which means that the named elements are **essential**, but other elements may be added" (emphasis added). Accordingly, contrary to the Examiner's assertion, the organopolysiloxane is **necessarily present** (emphasis added) in the inventive rubber composition of the instant invention. Hakuta '407 fails to implicitly or explicitly disclose a composition as claimed. Clearly, this rejection is improper and should be withdrawn.

Additionally, Applicants respectfully submit that Hakuta '407 does not teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of liquid injection molding, wherein the rubber composition comprises a copolymer rubber (A) and an organopolysiloxane (B).

As discussed above, Hakuta '407 does not disclose a composition similar to that of the present invention. Accordingly, the Examiner's assertion that "the injection molding process should be a liquid injection molding because the composition reads on Applicants' composition" is incorrect.

Hakuta'407 discloses an ethylene/α-olefin/non-conjugated polyene random copolymer rubber (A) having an intrinsic viscosity (η), as measured in decalin at 135°C, of 0.01 to 2 dl/g (see Hakuta '407 at column 3, lines 53-60). However, Hakuta'407 does not teach or suggest that the SiH group-containing compound (B) is in the liquid state. Furthermore, Hakata '407 teaches away from the present invention by exemplifying that the random copolymer rubber (A) is in the solid state (see "Examples").

The Examiner's attention is directed to column 13, lines 39-47 in Hakuta '407. In the cited section, Hakuta'407 teaches that the SiH group-containing compound (B) is used in an amount up to 100 parts by weight based on 100 parts by weight of the ethylene/α-olefin/non-conjugated polyene random copolymer rubber (A). One of ordinary skill in the art would thus recognize that the mixture could not be in the liquid state. The present inventors have discovered unexpected advantages by using liquid injection molding to mold a rubber composition comprising a copolymer rubber (A) possessing a specific range of intrinsic viscosity (0.01 to less than 0.3 dl/g), where the copolymer rubber (A) remains in the liquid state. Hakuta '407 fails to teach or suggest these limitations.

Clearly, Hakuta '407 fails to explicitly or implicitly teach each and every aspect of the present invention. Reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 16-17 and 22-27

Claims 16-17 and 22-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta (WO 00/55251 and its U.S. equivalent, U.S. 6,864,315) (hereinafter Hakuta '315). This rejection is respectfully traversed.

The Examiner asserts that Hakuta '251 discloses a method of preparing molded products made of various rubber compositions. The Examiner further asserts that the rubber compositions can be kneaded, crosslinked and injection molded. The Examiner acknowledges that Hakuta '251 "is silent on the specified claimed intrinsic viscosity", but asserts that it would be obvious to one skilled in the art to utilize a copolymer (A) having the claimed intrinsic viscosity "in order to afford a composition with a desired viscosity with expected success".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references to obtain the invention. Second, there must be a reasonable expectation of success in making the invention. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Hakuta '251 does not teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of liquid injection molding, wherein the rubber composition comprises a copolymer (A) of specific properties and an organopolysiloxane (B).

Furthermore, although Hakuta '251 discloses that the copolymer rubber (A) may be a liquid, the preferred embodiments are directed to copolymer rubbers that are not in the liquid state. The working examples of Hakuta '251 clearly evidence that the copolymer rubber (A) and the resultant rubber composition are kneaded in the melt state or nearly melt state under heating and are subjected to extrusion, injection or press molding. As is known in the art, a copolymer rubber having an intrinsic viscosity lower than 0.3 dg/l is in the liquid state. However, when the intrinsic viscosity exceeds 0.30 dl/g, the liquid viscosity rises suddenly and the copolymer rubber becomes a starch syrup and cannot be handled as a liquid. Clearly, one skilled in the art would recognize that the copolymer rubber (A) disclosed by Hakuta '251 is not in the liquid state, as opposed to the copolymer of the present invention.

Additionally, Hakuta '251 fails to teach or suggest a copolymer rubber (A) having an intrinsic viscosity of 0.01 to less than 0.3 dg/l. The Examiner's attention is directed to claim 4 of Hakuta '251. Claim 4 of Hakuta '251 clearly discloses that the ethylene/α-olefin/non-conjugated polyene random copolymer rubber (A) of the crosslinkable rubber composition has an intrinsic viscosity (η), as measured in decalin at 135°C, in the range of 0.3 to 10 dl/g. Clearly, Hakuta '251 teaches away from the present invention, which requires a copolymer rubber (A) having an intrinsic viscosity **lower than 0.3 dl/g** (emphasis added).

The Examiner asserts that Hakuta '251 "teaches that in general a decrease in the viscosity of a composition is desirable". The Examiner asserts that this teaching is found at column 2, lines 24-37 of Hakuta '251. Applicants respectfully disagree. The cited passage of Hakuta '251 describes the addition of reinforcements and fillers used to increase product hardness. When a rubber product is molded in the melt or nearly melt state, the compounding of the reinforcements or fillers impairs processability and increases the viscosity of the rubber product. Thus, techniques to decrease the viscosity of the compounded rubber product are employed.

Clearly, Hakuta '251 does not teach or suggest the use of a copolymer rubber (A) having an intrinsic viscosity of 0.01 to less than 0.3 dg/l, or provides any motivation to modify the viscosity of the disclosed copolymer rubber (A). Hakuta '251 merely discloses the fact that techniques are used to lower the viscosity of solid compounded rubber products in order to perform extrusion or injection molding.

Evidently, the cited reference fails to teach or suggest every limitation of the instant invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 23 and 25

Claims 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta '407 optionally in view of Hakuta '251. This rejection is respectfully traversed.

As discussed above, Hakuta '407 and Hakuta '251, alone or in combination, fail to teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use

of liquid injection molding, wherein the rubber composition comprises a copolymer (A) of specific properties and an organopolysiloxane (B).

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 26 and 27

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hakuta '407 in view of Hakuta '251. This rejection is respectfully traversed.

As previously discussed, Hakuta '407 and Hakuta '251, alone or in combination, fail to teach or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk driver by molding a rubber composition into a molded product with the use of liquid injection molding, wherein the rubber composition comprises a copolymer (A) of specific properties and an organopolysiloxane (B).

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By _____

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